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REMARKS

Applicant thanks the Examiner for the courtesy extended to Applicant's representative Larry Cullen and inventor David Resuta during a telephone interview on June 16, 2005.

During the interview, Applicant explained Applicant's invention and the prior art. Applicant presented a proposed amendment to claim 1 which is similar to the above amendment. Applicant explained that the prior art does not disclose a call agent simulator which uses runtime interpretive programming language to simulate a plurality of call actions in a VoIP network. The Examiner agreed to consider applicant's amendment and response upon presentation.

I. Introduction

Claims 1-4, 6-9 and 13-18 are pending in the above application.

Claims 1-4, 6-9 and 13-18 stand rejected under 35 U.S.C. § 103.

Claims 5, 10-12, 19 and 20 have been cancelled without prejudice or disclaimer.

Claims 1, and 13 have been amended to more particularly point out that which Applicant regards as the invention therein. Claims 2, 6 and 7 have been amended to correct informalities or correspond with other amendments. No new matter has been added.

II. Prior Art Rejections

Claims 1-4, 7-9 and 13-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Barskiy et al. (U.S. Pat. No. 6,205,412) (hereafter "Barskiy") in view

of Houh (U.S. Pub. No. 2002/0015387). Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Barskiy in view of Houh in view of Thayer et al. (U.S. Pat. No. 6,351,455) (hereafter "Thayer").

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3rd 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

Neither Barskiy, Houh nor Thayer, taken alone or in combination, disclose or suggest testing a telephone operation in a VoIP network using a call agent simulator which is being configured to simulate a plurality of call actions using a runtime interpretive programming language without compiling, each call action having an associated expected result in the network, as essentially recited by amended claims 1 and 13. Barskiy discloses a simulation of a switched telephone system (Abs). As recognized by the Office action Barskiy does not disclose using a simulation in a VoIP system or to use a runtime interpretive language. Houh discloses to test a device to be connected to a VoIP network by using an "emulated network" (Fig. 3). Houh does not connect a simulator which uses a runtime interpretive language to the VoIP network. Thayer discloses a technique to test devices in a CDMA cellular phone network and mentions Perl as a possible computer language to use for "metascript" data (Abs.; col. 6: 14-20).

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Thayer does not disclose connecting a call agent simulator to a VoIP network and use a runtime interpretive programming language to simulate call actions. At best, Thayer simply confirms the mere existence of the Perl computer language.

Accordingly, as neither Barskiy, Houh nor Thayer, taken alone or in combination, disclose or suggest all of the limitations of amended claims 1 or 13, the combination of Barskiy, Houh and Thayer does not render amended claims 1 or 13 unpatentable. Likewise, as claims 2-4 and 6-9 depend on claim 1 and claims 14-18 depend on claim 13, and incorporate all of the limitations thereof, respectively, claims 2-4, 6-9 and 14-18 are also not rendered unpatentable by the combination of Barskiy, Houh and Thayer.

Furthermore, any suggestion that the threeway combination of the disparate teachings of Barskiy, Houh and Thayer, would lead one of skill in the art to come up with Applicant's claimed invention would clearly rely on impermissible hindsight. It is well established that the fact that the prior art could be modified so as to result in the combination defined by the claims at bar would not have made the modification obvious unless the prior art suggests the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). Recognizing, after the fact, that such a modification would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 379 f.2d 1011, 154, USPQ 173 (CCPA 1967).

In the present case, two of the three references (Barskiy and Thayer) are not concerned with a VoIP network environment, and clearly, do not provide the requisite

motivation to be utilized in such environment. Notably, Houg explains some differences between a VoIP environment and a switched telephone network, and explains that a conventional switched network with dedicated channels does not face the same problems as a VoIP network (Houg, ¶s 0003-0010). Hence, one of skill in the art reading Houg would not be motivated to look to testing solutions used in a switched network with dedicated channel, and would likely be taught away from such. Accordingly, as none of Barskiy, Houg, nor Thayer suggest to be combined together, the conclusion to make such a combination could only be arrived at by improperly using Applicant's invention as a roadmap, i.e. a recognizing, after the fact, that such a modification would provide an improvement or advantage. As such, the combination would be based on improper hindsight.

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III. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

Date: 6/17/05   Respectfully submitted,

                                                   By: _____
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